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**CENTRAL FAX CENTER****JUL 31 2007****PATENT**

Atty. Dkt. No. YOR920030510US1

**REMARKS**

In view of the following discussion, the Applicants submit that none of the claims now pending in the application are directed to non-statutory subject matter under the provisions of 35 U.S.C. §101 or anticipated under the provisions of 35 U.S.C. §102. Thus, the Applicants believe that all of the presented claims are in condition for allowance.

**I. OBJECTION TO THE SPECIFICATION****A. Informalities**

The Examiner objects to the Specification for informalities. Specifically, the Examiner suggests that the phrase "framework objects 226-233" in paragraph [0048] should read "framework objects 226-231, 272, and 274". In response, the Applicants have amended paragraph [0048], as indicated above, in accordance with the Examiner's suggestion. Accordingly, the Applicants respectfully request that the objection to the Specification be withdrawn.

**B. Trademarks**

The Examiner notes that trademarks used in the Specification should be capitalized wherever they appear and accompanied by the appropriate generic terminology. In response, the Applicants have amended paragraphs [0002] and [0043], as indicated above, in order to properly denote trademarks used therein.

Specifically, the Specification has been amended to capitalize all trademarks used therein of which the Applicants are aware and to provide the generic terminology for the goods or services to which each of the trademarks refers. The Applicants have made every effort to appropriately designate every trademark of which they are aware in the Specification. If the Examiner still believes that a particular term used in the Specification is a trademark and has not been designated as such appropriately, it is respectfully requested that the Examiner alert the Applicants to the particular term(s) so that appropriate amendments can be made, if necessary. Accordingly, the Applicants respectfully request that the objection to the Specification be withdrawn.

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**II. REJECTION OF CLAIMS 26-27 AND 29-31 UNDER 35 U.S.C. §101**

The Examiner objects to claims 26-27 and 29-31 under 35 U.S.C. §101, for being allegedly directed to non-statutory subject matter. Specifically, the Examiner alleges that claims 26-27 and 29-31 "recite nothing but the physical characteristics of a form of energy". The Applicants respectfully traverse the rejection.

Claims 26-27 and 29-31 recite computer-readable media for storing software instructions for customizing a rule-based application. As the Supreme Court has recognized, Congress chose the expansive language of 35 USC §101 so as to include "anything under the sun that is made by man" as statutory subject matter. *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09, 206 USPQ 193, 197 (1980) (MPEP 2106, emphasis added). The Applicants respectfully submit that computer-readable media, including acoustic or light waves carrying instructions that are readable by a processor, are made by man and are not naturally occurring phenomena.

The Examiner nevertheless submits that "the phrase 'anything under the sun that is made by man' is limited by the text of 35 U.S.C. 101, meaning that one may only patent something that is a machine, manufacture, composition of matter or a process" (emphasis added). The Applicants submit that a computer-readable medium, including acoustic or light waves carrying instructions that are readable by a processor, qualifies as a "manufacture" under the provisions of 35 U.S.C. §101, which allows for a broad interpretation of the term "manufacture" (See, e.g., MPEP 2105). For instance, the Court in *Chakrabarty* found that "in choosing such expansive terms as 'manufacture' and 'composition of matter,' modified by the comprehensive 'any,' Congress plainly contemplated that the patent laws would be given wide scope". The Court further found that a "nonnaturally occurring manufacture or composition of matter - a product of human ingenuity -having a distinctive name, character, [and] use" is patentable subject matter (emphasis added). As discussed above, computer readable media – even including acoustic or light waves – that carries instructions readable by a processor is not a naturally occurring phenomena, but rather owes existence to human ingenuity and intervention that bestows "new forms, qualities, properties, or combinations". Thus, the Applicants respectfully submit that the invention recited in claims 26-27 and 29-31 is at least a "manufacture" within the meaning of 35 U.S.C. §101.

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Furthermore, to further clarify Applicants' claims, Applicants have amended claim 26 to recite "storing the ruleset". It is respectfully submitted that this clarification further bolsters Applicants' position with respect to the §101 rejection.

Accordingly, the Applicants respectfully submit that the subject matter to which claims 26-27 and 29-31 is drawn is patentable, and, as such respectfully request that the rejection of claims 26-27 and 29-31 under U.S.C. §101 be withdrawn.

#### **V. REJECTION OF CLAIMS 1-2, 4-15, 17-27, AND 29-31 UNDER 35 U.S.C. §102**

The Examiner rejects claims 1-2, 4-15, 17-27, and 29-31 as being anticipated under 35 U.S.C. §102(e) by the Grindrod patent (U.S. Patent No. 6,868,413, issued March 15, 2005, hereinafter referred to as "Grindrod"). The Applicants respectfully traverse the rejection.

The Examiner's attention is respectfully directed to the fact that Grindrod fails to teach or suggest the novel invention of designating a customizable element of a set as a customizable template, as recited in Applicants' independent claims 1, 14 and 26.

By contrast, the cited portions of Grindrod at most teach that a user (e.g., an administrator) can build expressions or conditions for business logic rules by entering variables into a user interface that has been dictated to the user. In other words, Grindrod teaches a method for completing a predefined "template" having predefined fields that are modifiable by a user (i.e., the user interface tells the user what is "customizable"). Nowhere in Grindrod is a method taught in which the user interface - or a template - itself is created by designating which elements of a set will be customizable by a user (e.g., such that the user can decide what is customizable).

Thus, Grindrod fails to teach or suggest designating a customizable element of a set as a customizable template, as recited by Applicants' claims 1, 14 and 26. Specifically, Applicants' claims 1, 14 and 26 positively recite:

1. A method of customizing a rule-based application, the method comprising:  
designating a customizable element of a set as a customizable template;  
compiling said customizable element into at least one object to form a ruleset; and  
  
parsing said set to detect said customizable element designated as a customizable template. (Emphasis added)

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14. A system for customizing a rule-based application, the system comprising:  
means for designating a customizable element of a set as a customizable template;

means for compiling said customizable element into at least one object to form a ruleset; and

parsing said set to detect said customizable element designated as a customizable template. (Emphasis added)

26. A computer-readable media for storing software instructions for customizing a rule-based application, which when executed by a processor perform the steps of:

designating a customizable element of a set as a customizable template;

compiling said customizable element into at least one object to form a ruleset;

storing said ruleset; and

parsing said set to detect said customizable element designated as a customizable template. (Emphasis added)

Since Grindrod fails to teach or suggest designating a customizable element of a set as a customizable template, Grindrod does not teach or suggest each and every element of Applicants' claims 1, 14 and 26. Moreover, dependent claims 2, 4-13, 15, 17-25, 27, and 29-31 depend, either directly or indirectly, from independent claims 1, 14 and 26 and recite additional features. As such, and for at least the exact same reason set forth above, the Applicants submit that claims 2, 4-13, 15, 17-25, 27 and 29-31 are also not anticipated and are allowable.

Therefore, Applicants contend that claims 1-2, 4-15, 17-27 and 29-31 are patentable over Grindrod and, as such, fully satisfy the requirements of 35 U.S.C. §102. Thus, Applicants respectfully request that the rejection of claims 1-2, 4-15, 17-27 and 29-31 under 35 U.S.C. §102 be withdrawn.

## VI. CONCLUSION

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Thus, the Applicants submit that all of the presented claims fully satisfy the requirements of 35 U.S.C. §101 and 35 U.S.C. §102. Consequently, the Applicants believe that all of these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring the maintenance of the final action in any of the claims now pending in the application, it is requested that the Examiner telephone Mr. Kin-Wah Tong, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

7/31/07

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